

REMARKS

This paper is in response to the Office Action mailed on January 18, 2005, and the references cited therewith. Claims 1, 8, 16, 18 and 25 are amended and claims 2, 4, 7, 17, 19-21, 23-24 and 28-29 are canceled, such that claims 1, 3, 5-6, 8-16, 18, 22 and 25-27 are now pending in this application.

§102 Rejection of the Claims

Claims 1, 4-6, 8-10, 12-13, 15-17, 20-23, 25-28 were rejected under 35 USC § 102(b) as being anticipated by Ikeda et al. (U.S. Patent No. 4,925,743). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. '2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 5-6

Applicant can not find in Ikeda any teaching or suggestion of the "heating composition including any combination of iron powder, water, water-retaining agent, reaction promoter and salt" as recited in amended claim 1. The Examiner acknowledges at the bottom of page 3 of the Office Action that "Ikeda et al. fails to disclose the heat patch further comprising any combination of iron power, water, water-retaining agent, reaction promoter and salt." Since Ikeda does not include each and every element of claim 1, the §102 rejection should be withdrawn.

Claims 5-6 depend from claim 1 such that claims 5-6 incorporate all the limitations of claim 1. Therefore, Ikeda does not appear to describe the subject matter of claims 5-6 for the reasons provided above with regard to claim 1 (among other reasons).

Reconsideration and allowance of claims 1 and 5-6 are respectfully requested.

Claims 8-10, 12-13 and 15

Applicant can not find in Ikeda any teaching or suggestion of “an enclosure that includes a gas-permeable layer and a reflective layer attached to said gas-permeable layer” in combination with “a heating composition sealed inside said gas-permeable layer and said reflective layer” as recited in amended claim 8. Applicant respectfully directs the Examiner’s attention to col. 3, lines 40-51, and FIGS. 1 and 2 of Ikeda which describe placing a reflecting means 3 onto an enclosure such that the reflecting means 3 does not form part of the enclosure. Since the reflecting means 3 in Ikeda does not form part of enclosure, Ikeda does not teach or suggest sealing a heating composition inside a gas-permeable layer and a reflective layer.

Claims 9-10, 12-13 and 15 depend from claim 8 such that claims 9-10, 12-13 and 15 incorporate all the limitations of claim 8. Therefore, Ikeda does not appear to describe the subject matter of claims 9-10, 12-13 and 15 for the reasons provided above with regard to claim 8 (among other reasons).

Reconsideration and allowance of claims 8-10, 12-13 and 15 are respectfully requested.

Claims 16 and 22

Applicant can not find in Ikeda any teaching or suggestion of “applying a heat patch to a portion of the body such that a reflective layer on the heat patch engages the body” as recited in amended claim 16. The Examiner acknowledges at the bottom of page 4 of the Office Action that “Ikeda et al. fails to disclose the reflective layer on the heat patch is attached or adhered to the patient's body.” Since Ikeda does not include each and every element of claim 16, the §102 rejection should be withdrawn.

Claim 22 depends from claim 16 such that claim 22 incorporates all the limitations of claim 16. Therefore, Ikeda does not appear to describe the subject matter of claim 22 for the reasons provided above with regard to claim 16.

Reconsideration and allowance of claims 16 and 22 are respectfully requested.

Claims 25-27

Applicant can not find in Ikeda any teaching or suggestion of “applying the heat patch to a portion of the body such that the reflective layer is attached to the body” as recited in amended claim 25. As discussed above, the Examiner acknowledges at the bottom of page 4 of the Office Action that “Ikeda et al. fails to disclose the reflective layer on the heat patch is attached or adhered to the patient's body.” Since Ikeda does not include each and every element of claim 25, the §102 rejection should be withdrawn.

Claims 26-27 depend from claim 25 such that claims 26-27 incorporate all the limitations of claim 25. Therefore, Ikeda does not appear to describe the subject matter of claims 26-27 for the reasons provided above with regard to claim 25 (among other reasons).

Reconsideration and allowance of claims 25-27 are respectfully requested.

First §103 Rejection of the Claims

Claims 2, 18 and 19 were rejected under 35 USC § 103(a) as being unpatentable over Ikeda et al. in view of Augustine et al. (U.S. Patent No. 6,580,012). Claim 2 has been canceled such that the rejection of claim 2 is moot.

In order to establish a prima facie case of obviousness, the references must teach or suggest all the claim elements. See M.P.E.P. § 2142 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As discussed above, Applicant can not find in Ikeda any teaching or suggestion of “applying a heat patch to a portion of the body such that a reflective layer on the heat patch engages the body” as recited in amended claim 16. The Examiner acknowledges at the bottom of page 4 of the Office Action that “Ikeda et al. fails to disclose the reflective layer on the heat patch is attached or adhered to the patient's body.”

Applicant also can not find in Augustine any teaching or suggestion of “applying a heat patch to a portion of the body such that a reflective layer on the heat patch engages the body” as recited in amended claim 16. Applicant respectfully directs the Examiner attention to FIG. 10 and col. 7, lines 1-3 of Augustine, which appear to be the only portions of Augustine that describe accessory device 55. Applicant notes that Augustine does not appear to describe engaging accessory device 55 with the body.

Claims 18 and 19 depend from claim 16 such that claims 18 and 19 incorporate all the limitations of claim 16. Therefore, Ikeda does not appear to describe the subject matter of claims 18 and 19 for the reasons provided above with regard to claim 16. Since Ikeda and/or Augustine do not include each and every element of claims 18 and 19, the §103 rejection should be withdrawn.

As part of making the rejection, the Examiner states at the middle of page 3 of the Office Action that “at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ikeda et al., as taught by Augustine et al., to provide an alternative means of heating the patch and the patient during thermo-therapy.” Applicant respectfully traverses these assertions because Applicant can not find any teaching or suggestion in Ikeda relating to using a resistive element to heat a patch. In addition, Applicant can not find any teaching or suggestion in Augustine relating to using an exothermic reaction to heat a patch.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). Applicant respectfully submits that the statement made by the Examiner regarding a motivation to combine Ikeda and Augustine is a mere conclusory statement of subjective belief because the statement is similar to the statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

“With respect to Lee’s application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner’s conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’

W.L. Gore V. Garlock, Inc., 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Applicant respectfully requests that the Examiner cite with particularity some support for the assertion made in the Office Action.

Reconsideration and allowance of claims 18 and 19 are respectfully requested.

Second §103 Rejection of the Claims

Claims 7 and 11 were rejected under 35 USC § 103(a) as being unpatentable over Ikeda et al. in view of Burkett et al. (U.S. Patent No. 5,918,590). Applicant has canceled claim 7 such that rejection of claim 7 is moot. A *prima facie* case of obviousness has not been established against claim 11 because (i) Ikeda and Burkett do not disclose either singularly, or in combination, the invention as claimed in claim 11; and (ii) there is no reason or motivation to combine Ikeda and Burkett.

I. Ikeda and Burkett Do Not Teach or Suggest Every Element of Claim 11

Applicant can not find in Ikeda and/or Burkett any teaching or suggestion of “an enclosure that includes a gas-permeable layer and a reflective layer attached to said gas-permeable layer” in combination with “a heating composition sealed inside said gas-permeable layer and said reflective layer” as recited in amended claim 8. As discussed above, the reflecting means 3 in Ikeda is placed onto the enclosure and does not form part of the enclosure. Therefore, Ikeda does not teach or suggest an enclosure sealing a heating composition inside a gas-permeable layer and a reflective layer. Applicant notes that there appears to be no description in Burkett relating to a reflective layer.

Claim 11 depends from claim 8 such that claim 11 incorporates all the limitations of claim 8. Therefore, Ikeda does not appear to describe the subject matter of claim 11 for the reasons provided above with regard to claim 8 (among other reasons). Since Ikeda and/or Burkett do not include each and every element of claims 11, the §103 rejection should be withdrawn.

II. There is No Motivation or Suggestion to Combine Ikeda and Burkett

As part of making the rejection, the Examiner states at page 4 of the Office Action that “at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ikeda et al., as taught by Buckett et al., to provide an alternative equivalent composition as the chemical source for the heat patch to heat the patient's skin for thermo-therapy.” Applicant respectfully traverses this assertion in part because Applicant can not find any teaching or suggestion in Burkett relating to using a reflective layer.

Applicant respectfully submits that the statement made by the Examiner regarding a motivation to combine Ikeda and Burkett is again a mere conclusory statement of subjective belief because the statement is analogous to the statements made by the Examiner and board in *In re Lee* (see quote from *In re Lee* above). Applicant respectfully requests that the Examiner cite with particularity some support for the assertion made in the Office Action.

Applicant respectfully notes that a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Applicant notes that Ikeda appears to teach away from Burkett because Ikeda teaches away from using any of compositions disclosed in Burkett (see, e.g., column 1, lines 30-50 of Ikeda). Applicant respectfully submits that upon reading Ikeda one of ordinary skill in the art would be discouraged from looking to Burkett such that there is no motivation to combine Ikeda with Burkett.

Reconsideration and allowance of claim 11 are respectfully requested.

Third §103 Rejection of the Claims

Claims 3 and 14 were rejected under 35 USC § 103(a) as being unpatentable over Ikeda et al. Applicant respectfully submits that a *prima facie* case of obviousness has not been established because Ikeda does not disclose the invention as recited in claims 3 and 14.

Claim 3

As discussed above, Applicant can find in Ikeda any teaching or suggestion of a “heating composition including any combination of iron powder, water, water-retaining agent, reaction promoter and salt” as recited in amended claim 1. The Examiner acknowledges at the bottom of page 3 of the Office Action that “Ikeda et al. fails to disclose the heat patch further comprising any combination of iron power, water, water-retaining agent, reaction promoter and salt.” Since Ikeda does not include each and every element of claim 1, the §102 rejection should be withdrawn.

Claim 3 depends from claim 1 such that claim 3 incorporates all the limitations of claim 1. Therefore, Ikeda does not appear to describe the subject matter of claim 3 for the reasons provided above with regard to claim 1 (among other reasons).

Reconsideration and allowance of claim 3 are respectfully requested.

Claim 14

Applicant can not find in Ikeda any teaching or suggestion of “an enclosure that includes a gas-permeable layer and a reflective layer attached to said gas-permeable layer” in combination with “a heating composition sealed inside said gas-permeable layer and said reflective layer” as recited in amended claim 8. As discussed above, the reflecting means 3 in Ikeda is placed onto the enclosure and does not form part of the enclosure. Therefore, Ikeda does not teach or suggest sealing a heating composition inside a gas-permeable layer and a reflective layer.

Claim 14 depends from claim 8 such that claim 14 incorporates all the limitations of claim 8. Therefore, Ikeda does not appear to describe the subject matter of claim 14 for the reasons provided above with regard to claim 8 (among other reasons).

Reconsideration and allowance of claim 14 are respectfully requested.

Fourth §103 Rejection of the Claims

Claims 24 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Ikeda et al. in view of Zhang et al. (U.S. Patent No. 6,453,648). Applicant has canceled claims 24 and 29 such that rejection is moot. However, Applicant is still addressing the rejection because of amendments to other claims.

As discussed above, Applicant can not find in Ikeda any teaching or suggestion of “applying a heat patch to a portion of the body such that a reflective layer on the heat patch engages the body” as recited in amended claim 16; or “applying the heat patch to a portion of the body such that the reflective layer is attached to the body” as recited in amended claim 25. The Examiner acknowledges at the bottom of page 4 of the Office Action that “Ikeda et al. fails to disclose the reflective layer on the heat patch is attached or adhered to the patient's body.”

Applicant notes that there does not appear to be any description in Zhang relating to a reflective layer such that Zhang can not teach or suggest “applying a heat patch to a portion of the body such that a reflective layer on the heat patch engages the body” as recited in amended claim 16; or “applying the heat patch to a portion of the body such that the reflective layer is attached to the body” as recited in amended claim 25. Therefore, the combination of Ikeda and Zhang do not establish a *prima facie* case of obviousness against claims 16 and 25 because Ikeda and Zhang do not disclose either singularly, or in combination, the invention as claimed in claims 16 and 25.

As part of making the rejection, the Examiner states at the bottom of page 4 of the Office Action that “Zhang et al. disclose a heating device similar to the one disclosed by Ikeda et al., wherein the patch is adhered to the patient's skin during therapy (col. 8, lines 38-48).” Applicant respectfully traverses this assertion because the patch in Zhang is not similar to the patch in Ikeda as the patch in Zhang does not include a reflective layer.

In addition, Applicant notes that Ikeda appears to teach away from Zhang because Ikeda teaches away from using any of compositions disclosed in Zhang (see, e.g., column 1, lines 30-50 of Ikeda). Applicant respectfully submits that upon reading Ikeda one of ordinary skill in the art would be discouraged from looking to Zhang such that there is no motivation to combine Ikeda with Zhang.

The Examiner further states that “at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ikeda et al., as taught by Zhang et al., to adhere the patch and the associated reflective layer to the patient's skin.” Applicant respectfully traverses this assertion because Applicant can not find any teaching or suggestion in Ikeda or Zhang relating to adhering a reflective layer to the skin.

In addition, Applicant respectfully submits that the statement made by the Examiner regarding a motivation to combine Ikeda and Zhang is a mere conclusory statement of subjective belief because the statement is again similar to the statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Applicant respectfully requests that the Examiner cite with particularity some support for the assertion made in the Office Action.

Reservation of Right to File Continuation or Divisional Applications

Applicant respectfully traverses the rejection listed above and reserves the right to reintroduce any claims their original form in one or more continuation or divisional applications at a later date.

Reservation of Right to Swear Behind References

Applicant reserves the right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14 day of March, 2005.

CANDIS BUENDING

Name

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